

## **REMARKS**

### **I. Preliminary Remarks**

At page 2 of the Office Action, the Examiner stated that Applicants' request for reconsideration of the finality of the previous office action was persuasive and the finality of the previous action was withdrawn. Therefore, the Applicants hereby withdraw the Notice of Appeal filed March 15, 2010.

### **II. The Rejection Under 35 U.S.C. 112, Second Paragraph Should be Withdrawn**

Claim 94 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The Examiner asserted that the language of claim 94 expands the scope of claim 84, from which it depends. Applicants believe claim 94 as filed limited the scope of claim 84. However, in order to expedite prosecution, claim 94 is amended to be independent and therefore the rejection is now moot.

In view of the foregoing amendment and remarks, claim 94 is clear and definite and the rejection under 35 U.S.C. § 112, second paragraph should be withdrawn.

### **III. The Provisional Double Patenting Rejection Should be Withdrawn.**

Claims 84, 85, 87-92, 94-107, 109 and 110 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly not being patentable over the claims of U.S. Patent Application Nos. 10/801,493 and 11/713,091. Applicants request that these rejection by withdrawn for the following reasons.

#### **A. U.S. Patent Application No. 10/801,493**

The claims in copending U.S. Application No. 10/801,493 are directed to methods of using a substrate comprising four amino acids defined by formula  $P_2P_1-P_1P_2$ , wherein:  $P_2$  is N;  $P_1$  is F,  $P_1$  is E; and  $P_2$  is A. The pending claims of the present application are directed to methods using a substrate comprising four amino acids defined by formula  $P_2P_1-P_1P_2$ , wherein:  $P_2$  is F rather than A. As these claims encompass different substrates, neither invention renders the other obvious.

Because the currently pending claims and the claims of U.S. Patent Application No. 10/801,493 are distinct and do not render each other obvious, the

obviousness-type double patenting rejection in view of U.S. Patent Application No. 10/801,493 should be withdrawn.

**B. U.S. Patent Application No. 11/713,091**

Copending U.S. Application No. 11/713,091 was filed after the present application and is currently under examination. The MPEP instructs that “[i]f a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.” See MPEP §804. Thus, the obviousness-type double patenting rejection in view of U.S. 11/713,091 should be withdrawn.

**CONCLUSION**

In view of the above amendment and remarks, Applicants believe pending claims 84, 85, 87-92, 94-107, 109 and 110 are in condition for allowance.

Dated: June 17, 2010

Respectfully submitted,

Electronic signature: /Sharon M. Sintich/  
Sharon M. Sintich  
Registration No.: 48,484  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorney for Applicant